

REMARKS

Claims 1-15 and 17-21 are pending. Claims 2, 4, 6-15, and 17-21 have been withdrawn from consideration. Claims 1, 3, and 5 were provisionally rejected under 35 U.S.C. § 101, and were rejected under 35 U.S.C. § 102. Applicants address each of these rejections as follows.

Claim Amendments

Claim 1 has been amended to recite the definition of a serotonin-gated anion channel found at page 16, lines 5-8, of the specification. As this amendment merely incorporates the definition of a serotonin-gated anion channel, a term which was present in the original claim, into claim 1, this amendment cannot raise new issues. Claims 2, 4, 6-15, and 17-21, which were directed to a non-elected invention, have been canceled.

Rejection under 35 U.S.C. § 101

Claims 1, 3, and 5 were provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1, 3, and 5 of co-pending U.S. Patent Application No. 09/559,622 (“the ‘622 application”). Applicants note that in the Supplemental Amendment filed on September 9, 2003 in the ‘622 application, Applicants canceled claims 1, 3, and 5. In an Advisory Action mailed on November 19, 2003 in the ‘622 application, the Office stated that the amendments set forth in the September 9th Supplemental Amendment will not be entered as they raise new issues.

Applicants hereby affirm that they intend to cancel claims 1, 3, and 5 in the '622 application.

Rejection under 35 U.S.C. § 102(b)

Claims 1, 3, and 5 were rejected under 35 U.S.C. § 102(b) as being anticipated by Blakely et al. (*Nature* 354:66-70, 1991; "Blakely"), Corey et al. (*Proc. Natl. Acad. Sci. USA* 91:1188-1192, 1994; "Corey"), Demchyshyn et al. (*Proc. Natl. Acad. Sci. USA* 91:5158-5162, 1994; "Demchyshyn"), Olde et al. (*J. of Molecular Neuroscience* 8:53-62, 1997; "Olde"), and Ramamoorthy et al. (*Proc. Natl. Acad. Sci. USA* 90:2542-2546, 1993; "Ramamoorthy"). In particular, the Office states:

Olde *et al.*, Ramamoorthy *et al.*, Demchyshyn *et al.* and Blakely *et al.* do not teach the specific nucleic acid sequence taught in the specification for mod-1 isolated from *C. elegans*, however given the breadth of the instant claims encompassing any variant, the various serotonin transmembrane transporters/receptors taught by the cited references would anticipate the invention as instantly claimed ... In light of the breadth of the present claims, the polynucleotide sequences taught by Demchyshyn *et al.*, Corey *et al.*, Olde *et al.*, Ramamoorthy *et al.* and Blakely *et al.* meet the limitations of the claims and thus, anticipate claims 1, 3, and 5.

Applicants disagree for the following reasons.

To anticipate a claim, the prior art has to teach each and every element set forth in that claim. Applicants have amended claim 1 to recite the definition of a "serotonin-gated anion channel" as provided in the specification at page 16, lines 5-8. A serotonin-gated anion channel, as defined in Applicants' specification, and as recited in claim 1, is a

channel which is regulated by serotonin binding and permits the passage of anions from one side of a membrane to the other.

None of the cited references teaches a serotonin-gated anion channel. Instead, Blakely, Corey, Demchyshyn, Olde, and Ramamoorthy teach serotonin transporters and G-protein-coupled serotonin receptors. These proteins are not serotonin-gated anion channels that permit the passage of anions from one side of a membrane to the other and, therefore, do not meet the limitations of claim 1. The 35 U.S.C. § 102 rejection of claim 1, and its dependent claims, should be withdrawn.

Assertion of Small Entity Status

Applicants hereby assert that the present application is entitled to small entity status under 37 C.F.R. § 1.27(c)(1).

CONCLUSION


Applicants submit that the application is in condition for allowance and such action is respectfully requested.

Enclosed is a petition to extend the period for replying for three months, to an including December 15, 2003, as December 13th was a Saturday, as well as a check in payment, as a small entity, of the required fee. Also enclosed is a Notice of Appeal, in which Applicants respectfully appeal the final rejection of the pending claims.

If there are any other charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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